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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,091	11/24/2003	Terry L. Davis	991386	1940

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United States Army Legal Services Agency
Suite 527
901 North Stuart Street
Arlington, VA 22203-1837

EXAMINER

RICHARDSON, JOHN A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,091

Applicant(s)

DAVIS, TERRY L.

Examiner

John Richardson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11-24-2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Non Final Rejection

- 1). Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to an apparatus, classified in class 408, subclass 72.
 - II. Claims 12-19, drawn to a process, classified in class 42, subclass 90.

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to practice another and materially different process such as threading tapping holes in work pieces requiring removal.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2). During a telephone conversation with Alan Klein (703-696-8113) on June 23 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3). The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4). Claims 1 to 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasselmann (U.S. 4,407,086).

The reference discloses a means for removing a lodged ordnance component (item 55) from a weapon (item 11) that reads on the applicant's claims comprising a tool with a threaded tip / starter tap (item 17), a holder for the said threaded tip tool / starter tap (item 29), a means for screwing / shaking the said damaged ordnance for removal from the said weapon (Column 2, lines 10-43), one set screw securing said threaded tip tool / starter tap to said holder (item 30), a grip / holder (item 41), a spacer bushing (item 45) connected to the center of the said grip / handle, a composite shaft arrangement (items 13, 15) connected to the said holder with one end in contact with the said spacer bushing, a knurled slider on the said shaft detail (item 46), relating to claims 2, 9, 11, the reference discloses a handle (item 41) for actuating / running the said screw-jag tool into the said ordnance component, relating to claim 3, the said grip / handle includes a bushing detail (item 45), relating to claims 4-5, the reference discloses a holder (item 30) for the said threaded tip tool / starter tap, relating to claim 6, the reference discloses a set screw (item 30), relating to claims 7-8, the reference discloses slider (item 46) in contact with the said composite shaft.

It is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from prior art apparatus" if the prior art teaches all the structural limitations of the claim. *In re Masham*, 2 USPQ2d 1647.

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Claims directed to apparatus must be distinguished from prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device *is*, not what a device *does*. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP§ 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

5). Claims 1 to 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Harchar (U.S. 5,225,614).

The reference discloses an extraction apparatus for removing an ordnance (item 20) from a firearm comprising a screw-jag tool / starter tap (item 24, a means for running said screw-jag tool / starter tap into the damaged ordnance (item 18), a means for turning / twisting shaking (Column 3, lines 40-52) damaged ordnance loose (refer to Merriam – Webster Collegiate Dictionary, 10th. Edition, defining shaking as *involving–moving to and fro, or alternating motion*), relating to claim 2, the reference discloses a lever / handle (item 40), relating to claims 3-5, the reference discloses a holder / shaft (item 18) for said screw-jag tool / starter tap, and a bushing (item 32).

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6). Claims 1 to 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mirles (U.S. 5,573,357).

The reference discloses an apparatus (item 10) for running a tap into a work piece comprising a starter tap (item 30), a means for shaking the said apparatus using a pneumatic motorized power tool (item 24), relating to claim 2-5, the reference discloses a plurality of handles (items 12, 14), a holder (item 32), a shaft axis (item 34), and a bushing detail (96) for the said tap.

7). The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8). Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Richardson whose telephone number is (703) 305 0764. The examiner can normally be reached on Monday to Thursday from 7.00 AM to 4.30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306 4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305 7687.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 1113.

John Richardson, PE,

June 23 2004.

John Richardson, PE 3641